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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,706	07/13/2001	Masamichi Ito	03500.012551.1	1058
5514 7590 09/26/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER NEURAUTER, GEORGE C	
			ART UNIT 2143	PAPER NUMBER
			MAIL DATE 09/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/903,706

Applicant(s)

ITO ET AL.

Examiner

George C. Neurauter, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 30-37 are currently presented and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 August 2007 has been entered.

Response to Arguments

The Applicant's arguments regarding Bell are persuasive and the rejections of claims 30-32 and 34-36 have been withdrawn.

However, the Applicant's arguments regarding "Olympus" have been considered and are not persuasive. The Applicant argues that "Olympus" does not teach or suggest controlling the data communication apparatus to stop inhibiting, invalidating or ignoring the predetermined user instruction in response to receiving notice from the printer that the image data selected by the user is printed. "Olympus" clearly discloses that "The Condition indicator LED lights while printing and other operations are disabled" (see page 128). It is clear from the

Art Unit: 2143

disclosures of "Olympus" that when the LED stops flashing, the printer is no longer receiving information since the information has been completely received and, therefore, printing is complete and the operations are no longer disabled. Therefore, "Olympus" does disclose this limitation.

The Applicant also argues that "Olympus" does not teach or suggest controlling the data communication apparatus to stop inhibiting, invalidating or ignoring the predetermined user instruction in response to disconnecting the data communication apparatus from the serial bus. The Examiner is not persuaded by this argument. When the user disconnects the data communication apparatus from the serial bus, the camera is no longer able to print since it is no longer connected to the printer. Therefore, in accordance with the teaching in "Olympus" that operations are disabled while printing, the data communication apparatus does not preclude the user anymore from entering instructions. Therefore, "Olympus" does at least reasonably suggest, if not teach, this limitation.

Therefore, the claims are not in condition for allowance.

Art Unit: 2143

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 30-37 recite "controlling the data communication apparatus to start inhibiting, invalidating, or ignoring a predetermined user instruction..." Claims 30-37 then recites "controlling the data communication apparatus to stop inhibiting, invalidating or ignoring the predetermined user instruction in response to receiving notice from the printer that the image data selected by the user is printed and controlling the data communication apparatus to stop inhibiting, invalidating or ignoring the predetermined user instruction in response to disconnecting the data communication apparatus from the serial bus". It is unclear whether which action actually stops the inhibiting, invalidating, or ignoring since the claim requires that both actions must occur but each action appears to separately stop the inhibiting, invalidating or ignoring,

Art Unit: 2143

therefore, the breadth of the claim as to what actually stops the inhibiting, invalidating or ignoring is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 30 and 34 are rejected under 35 U.S.C. 102(a) as being anticipated by "Olympus Digital Vision D-320L D-220L Digital Camera Instructions" ("Olympus").

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55.

The Examiner submits that an English translation is required for the purpose of determining the applicant's right to rely on the foreign filing date. See MPEP § 201.15.

Regarding claim 30, "Olympus" discloses a method of controlling a data communication apparatus, the method comprising the steps of:

controlling the data communication apparatus to send image data selected by a user to a printer via a serial bus, the image

Art Unit: 2143

data selected by the user being sent from the data communication apparatus in response to entering a send instruction into the data communication apparatus; (see at least page 128, specifically "By connecting the camera to the P-300U printer with the exclusive cable, pictures can be directly sent from the camera (3) Select the picture you want to print...")

controlling the data communication apparatus to start inhibiting, invalidating or ignoring a predetermined user instruction in response to entering the send instruction into the data communication apparatus and controlling the data communication apparatus to stop inhibiting, invalidating, or ignoring the predetermined user instruction in response to receiving notice from the printer that the image data selected by the user is printed and controlling the data communication apparatus to stop inhibiting, invalidating, or ignoring the predetermined user instruction in response to disconnecting the data communication apparatus from the serial bus. (see at least page 128, specifically "The Condition indicator LED lights while printing, and other operations are disabled")

Claim 34 is also rejected since this claim recites substantially the same limitations as recited in claim 30.

Art Unit: 2143

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that

Art Unit: 2143

was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 31-32 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Olympus" in view of US Patent 6 442 349 B1 to Saegusa et al.

Regarding claim 31, "Olympus" discloses a method according to claim 30.

"Olympus" does not expressly disclose further comprising the step of controlling the data communication apparatus to notify a user with a warning message in response to entering the predetermined user instruction into the data communication apparatus when the predetermined user instruction is inhibited, invalidated, or ignored, however, Saegusa does disclose this limitation in the context of providing instructions to a user on a data communication apparatus (see at least column 1, lines 49 and 52-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Saegusa discloses that notifying a user with a warning message prevents the user from entering commands when such an operation would be undesirable (see column

Art Unit: 2143

1, lines 52-56). In view of these specific advantages and that the references are directed to providing instructions to a user on a data communication apparatus, one of Ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claim 35 is also rejected since this claim recites substantially the same limitations as recited in claim 31.

Regarding claim 32, "Olympus" and Saegusa disclose the method according to claim 30.

"Olympus" discloses wherein the data communication apparatus is an apparatus including at least one video recording unit and at least one camera unit. (see references within "Olympus" to "camera")

Saegusa also discloses this limitation (see references within Saegusa to "camera").

Claims 33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Olympus" and Saegusa as applied to claims 30 and 34 above, and further in view of "IEEE 1394: A Ubiquitous Bus" ("IEEE 1394").

Art Unit: 2143

Regarding claim 33, "Olympus" and Saegusa disclose the method of claim 30.

"Olympus" and Saegusa do not expressly disclose wherein the serial bus conforms to IEEE 1394 standards, however, "IEEE 1394" does disclose such a communication bus in the context of image transferring (page 1, specifically "Its scalable architecture and flexible peer-to-peer topology make 1394 ideal for connecting devices from computers and hard drives, to digital audio and video hardware"; page 2, specifically "Broad markets for 1394 digital data transport include:...audio, image, and video products for multimedia, printer and scanner products for imaging...")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "IEEE 1394" discloses that using the IEEE 1394 bus allows for a universal I/O connection and a scalable architecture between devices such as printers and imaging devices (see page 1). In view of these specific advantages and that the references are directed transferring image data between nodes over a communication bus, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would

Art Unit: 2143

lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claim 37 is also rejected since this claim recites substantially the same limitations as recited in claim 33.

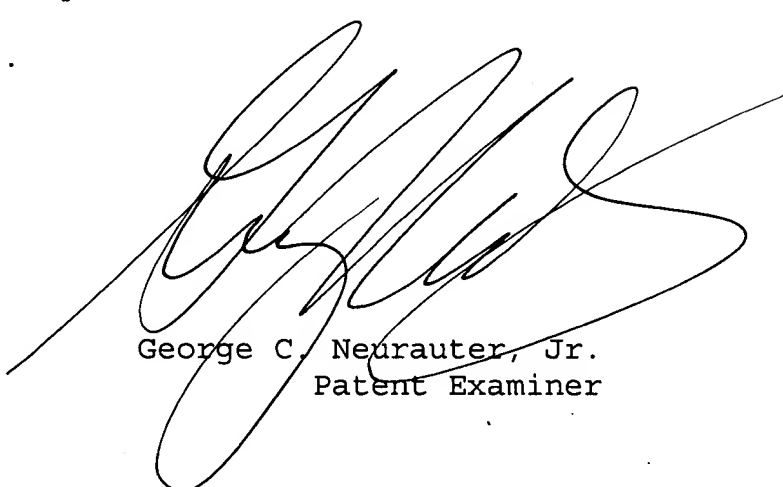
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



George C. Neurauter, Jr.
Patent Examiner